

Appl. No.: 09/944,165
Amendment dated February 27, 2006
Reply to Office Action of October 27, 2005

REMARKS

The final Office Action of November 17, 2005 has been carefully reviewed and these remarks are responsive thereto. By the present amendment, Applicants amend claims 1, 10, 23-26, 30, and 32, and cancel claims 12-16, 28-29, and 36. No new claims have been added. Claims 1, 3-8, 10, 17, 19, and 21-35 thus remain pending in the application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 31-32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants believe that claim 31 is definite as presented, and the Office Action does not cite any portion of claim 31 which the Office believes to be indefinite. Applicants request clarification if the rejection of claim 31 is maintained. Applicants have amended claim 32 to recite alternative claim language of the same scope, and respectfully submit that this rejection is rendered moot.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-8, 10, 12-17, 19, 21-27, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung *et al.* (U.S. Pat. No. 6,570,583, hereinafter Kung) in view of Phillips (U.S. Pat. No. 6,107,988). This rejection is respectfully traversed.

Claim 1 has been amended to incorporate the features of now canceled claim 36, rendering this rejection moot with respect to claims 1 and 3-8. Claim 1 will be addressed below, based on the rejection of now canceled claim 36.

Claim 10 has been amended to incorporate the features of claim 12. The Office Action indicates that Kung describes such features at col. 4, lines 40-54. However, Kung merely indicates that the zoom control could be a touch sensitive control *on the display of the device*. Kung does not teach or suggest the claimed method whereby:

when second user input is received through a second user input control capable of detecting a direction of user input, content on the display screen is zoomed in or out responsive to the detected direction of the second user input, the content on the display screen being zoomed in steps defined by a zoom-ratio, the zoom-ratio varying between a predetermined maximum zoom-ratio and a predetermined minimum zoom-ratio,

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wherein first and second user input controls are located on the back of the device,
wherein the display screen is located on the front of the device, and
wherein each input control comprises a touchpad.

Thus, neither Kung nor Phillips, nor a combination of the two, teach or suggest a touchpad on the back of a device, the touchpad usable to control a zoom level of content on a display screen on the front of the device.

Claims 12-16 have been canceled. Claim 17 is allowable for at least the same reason as claim 10.

With respect to claim 21, the Office apparently ignores the claim language. The claim language recites:

...horizontal panning is in a same direction as the received horizontal component of the first received user input, and wherein vertical panning is in a same direction as the received vertical component of the first received user input, thereby allowing the user to interact with the display as if the user is moving a displayed document with the user's finger.

The claimed feature is described at paragraph [0027] of the application as filed, which states that "the touch pad may be located behind the display. Thus, the user may interact with the display as if she is moving a physical object with her finger." That is, the user places his or her finger on the touchpad at a corresponding location to content on the display screen, and as the user moves his or her finger, the device moves the content on the display screen to always be at a corresponding location to the user's finger. Such a feature is not taught or suggested by either Kung or Phillips.

Claims 23-26 and 30 have been amended to recite that each user input control comprises a touch pad, similar as in other pending claims. No new search is believed to be required for such a feature as this feature is already incorporated into other pending claims and thus has already been searched by the Office. Claims 23-26 and 30 are allowable for at least the same reasons as discussed above.

The Office Action's rejection of claims 19, 22, and 27 is deficient in that the Office Action improperly substitutes the features of claim 1 for claims 19, 22, and 27. That is, the

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Office Action does not refer to the specific features of either claim 19, 22, and 27 in its rejection of claims 19, 22, and 27, but instead improperly substitutes the features of claim 1. Claim 1 and each of claims 19, 22, and 27 have differing scopes, and thus the substitution is improper. For example, claim 1 and the Office Action recite a “user input control,” whereas claims 19, 22, and 27 each recite a “touch pad.” Applicants respectfully request a subsequent Office Action, if the rejection is maintained, in order to afford Applicants a fair opportunity to address the Office’s concerns with respect to these claims during prosecution on the merits, as opposed to addressing them on appeal.

Applicants further note that neither Kung nor Phillips teach or suggest the use of a touchpad, on the back of a device, for zooming content on a display screen on the front of the device, as discussed above.

The Office Action also fails to address claim 33. Applicants respectfully request another Office Action, if the rejection is maintained, in order to afford Applicants a fair opportunity to address the Office’s concerns with respect to this claim.

Claims 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung and Phillips, and further in view of Tanaka (U.S. Pat. No. 6,473,796). Applicants have canceled claims 28-29, rendering this rejection moot.

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung and Phillips, and further in view of Sakai et al. (U.S. Pat. No. 4,509,841, hereinafter Sakai). This rejection is respectfully traversed.

The combination of Sakai with Kung and Phillips is deficient for the same reason as Nishimura was found deficient, and the same reason Applicants argue that Tanaka is deficient. Namely, that Sakai describes autofocus and zooming of a mechanical camera lens, whereas Kung and Phillips deal with zooming in the sense of enlarging content displayed on a display screen. The technologies are different, and the use of one does not motivate a skilled artisan to use the other. Applicants made similar arguments with respect to Nishimura, in response to which the Office reopened examination in the Notice of Panel Decision dated October 27, 2005.

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In addition, Applicants have amended claim 1 to recite the features of now canceled claim 36. Amended claim 1 now recites, *inter alia*, "said zoom-ratio is defined by a content application." The Office Action relies on Sakai for allegedly reciting such a feature. However, Sakai actually describes the use of different lenses for a camera, not a content application. Indeed, at the cited portion, Sakai states "...it varies when zoom *lenses* of different zoom ratios are used and it also become completely different between a telephoto application and a wide-angle application *of a zoom lens*." Sakai, col. 1, ll. 28-32 (emphasis added). Stated differently, Sakai describes a mechanical application, wherein different physical lenses may be used, whereas the claim recites a *content* application, which is software that originates, displays, and/or transmits the content. Thus, the rejection is traversed because there is no motivation to combine Sakai with the other references, and because even if the references were combined, they do not teach or suggest all the claimed features.

Claims 31 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung and Phillips, and further in view of Harada (U.S. Pat. No. 5,038,164). This rejection is respectfully traversed.

The combination of Harada with Kung and Phillips is deficient for the same reason as Nishimura was found deficient, and the same reason Applicants argue that Tanaka and Sakai are deficient. Namely, that Harada deals with zooming of a physical camera, whereas Kung and Phillips deal with zooming in the sense of enlarging content displayed on a display screen. The technologies are different, and the use of one does not motivate a skilled artisan to use the other.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung, Phillips, and Harada, and further in view of Neff et al. (U.S. Pat. No. 6,424,464, hereinafter Neff). This rejection is respectfully traversed, at least based on the improper combination of Kung and Phillips with Harada, as discussed above.

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CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 27 day of Feb., 2006

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